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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,859	02/01/2000	Stephen R. Beaton	VTN-0458	4043
7590 06/07/2004			EXAMINER	
Audley A Ciamporcero Jr One Johnson & Johnson Plaza New Brunswick, NJ 08933-7003			FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/494,859	Applicant(s) BEATON ET AL. 	
	Examiner David T. Fidei	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-18 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-18 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 4, 5, 6, 9, 17, 18, 39, 40, 41, 42 and 43 rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al (Patent no. 5,620,087). Martin discloses a packaging 10 for housing at least one contact lens manufactured by a manufacturer and prescribed by a doctor to a patient comprising an identification means 32a, 32b, 32c and customized graphics, see col. 4, lines 4-8 and col. 7, lines 16-20.

Claim 1 further recites said customized graphics consisting essentially of print produced by at least one printer and provided on at least some surface of said packaging. However, the process used to impart the printing is of no patentable significance in the product claim.ⁱ

The claims go on to further define the nature of the customized graphics. Claim 1 recites the graphics “being selected by the individual doctor prescribing said contact lens, wherein said customized graphics are specified at the time an order for said contact lens is placed with said manufacturer and said packaging is shipped from the manufacturer of said contact lens having said customized graphics and identification means on said packaging”. This also fails to provide any distinction over the product of Martin et al as person/persons selecting the graphics, the doctor prescribing the contact lens, the manufacturer or any other party involved does nothing to distinguish the graphics over any other graphics. Furthermore, the party selecting the graphics along with the time frame the graphics are placed on the contact lens packaging relates to the process of manufacturing. As noted previously, it is well established this produces no distinction over the final product of Martin et al as a product produced from a particular process of manufacture does not distinguish over a similar product having no differences from the final product claimed as made by the particular process. Accordingly, in light of the new changes made to claim 1, it is submitted claim 1 is anticipated by Martin et al (Patent no. 5,620,087).

The remaining claims can be considered as follows;

Claim 3 recites, "the customized graphics identifies the person who is to receive contact lens".

Claim 4 recites, "wherein said packaging does not identify the prescription"

Claim 5 recites, "wherein the customized graphics identifies said doctor prescribing said contact lens".

Claim 9 recites, "further comprising non-customized graphics, said non-customized graphics identifies the manufacturer of said contact lens".

Claim 17 recites, "wherein said customized graphics comprise alphanumeric characters".

Claim 18 recites, "wherein said customized graphics comprise pictures".

Claim 40 recites, "wherein the customized graphics is a picture of said doctor".

Claim 41 recites, "wherein said customized graphics and said identification means are added in-line".

Claim 42 recites "wherein said packaging does not identify the prescription", and;

Claim 43 recites, "wherein said customized graphics comprise a picture of the doctor"

These claims relate to the specific "printed matter" provided on the package. In order for such "printed matter" to distinguish the invention from prior art, in terms of patentability, the printed matter must be functionally related to the substrate in order to be entitled patentable weight. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and package.ⁱⁱ In the present case the specific graphics, customized or non-customized, does not interrelate the package with the specific graphics in the way the indicia interrelated with the band of Gulack's invention. Here the specific graphics provided on the package, Martin et al broadly suggesting instructions, advertising, logo's, company names or decorative indicia, does not depend upon the package and the package does not depend upon the printed matter. Adopting applicant's position (for patentability), anyone could continue patenting a product indefinitely provided that they added different graphics, advertisement, or indicia to the package. All the specific graphics, or printed matter, does is teach a different use of an existing product. Accordingly, the printed matter is of no patentable distinction.ⁱⁱⁱ

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Claim 6 recites, “ wherein said prescription product is shipped from the manufacturer of said prescription product having said customized graphics on said packaging”. This appears to be the intent of Martin et al. At least to the extent that the product is shipped from the manufacturer in its final form.

Claim 39 recites, “wherein said customized and non-customized graphics are added to the packaging simultaneously”. This relates to the process of manufacture. As noted previously, this language is of no patentable moment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 8, 10-13 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (Patent no. 5,620,087) as applied to claims 1, 3, 4, 5, 6, 9, 17, 18, 39, 40, 41, 42 and 43 above, and further in view of Abrams et al (Patent no. 5,697,495).

Claim 7 recites “the packaging of claim 1 wherein said packaging comprises primary packaging and secondary packaging and said customized graphics and said identification means are present on at least some surface area of said primary packaging or said second packaging”. This subject matter differs over Martin et al only by a secondary packaging. The customized graphics and said identification means are already present on at least some surface area of said primary packaging 10 in Martin et al.

Abrams et al deals with a similar problem as Martin et al, and the present invention, in that the patent is concerned with packaging contact lens. As with Martin et al, Abrams et al provides a primary package and further teaches a secondary package 10 made of a paperboard material for receiving the primary package 30, note figures 1 and 2. It would have been obvious

to one of ordinary skill in the art to modify the packaging of Martin et al by including a secondary package as taught by Abrams et al. The motivation for this modification is the closely related subject matter and the teaching of Abrams' secondary package providing a medium for shipping a plurality of primary packages.

As to claim 8, the customized graphics and said identification means are already present on at least some surface area of said primary packaging 10 in Martin et al.

Claim 10 is similar in content as claim 7, but depends from 10. As noted above, it would have been obvious to one of ordinary skill in the art to modify the packaging of Martin et al by including a secondary package as taught by Abrams et al, in order to provide a medium for shipping a plurality of primary packages. The customized graphics and said identification means are already present on at least some surface area of said primary packaging 10 in Martin et al.

As to claims 11 and 12, the primary package of Martin et al is a blister pack comprising a bowl 22 and a lidstock 34, wherein the customized graphics are printed onto the lidstock, see figures 3-5.

As to claim 13, printing is imparted to the film 30, which is adhered to the foil, or lidstock 34, see col. 7, lines 50-53. Hence the graphics are printed onto a "label" 30, which is adhered to the lidstock 34.

As to claims 36, the label comprises identifying means 32a, 32b or 32c.

5. Claims 14-16, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (Patent no. 5,620,087) as applied to claims 1, 3, 4, 5, 6, 9, 17, 18, 39, 40, 41, 42 and 43 above, and further in view of Abrams et al (Patent no. 5,697,495) and European Patent Application EP 0 734 957 A1. Claim 14 recites "the packaging of claim 9 wherein said packaging comprises primary packaging and secondary packaging and said customized graphics and are present on at least some surface area of said secondary packaging, said secondary packaging being a carton".

This subject matter differs over Martin et al only by a secondary packaging with customized graphics. As noted above, it would have been obvious to one of ordinary skill in the

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art to modify the packaging of Martin et al by including a secondary package as taught by Abrams et al, in order to provide a medium for shipping a plurality of primary packages.

European Patent Application EP 0 734 957 A1 is cited for the teaching of figure 1 where a secondary packaging 22 is provided with printed matter present on at least some surface area of said secondary packaging. It would have been obvious to one of ordinary skill in the art to modify the secondary packaging taught by Abrams et al by including printed matter thereon in view of EP 0 734 957 A1. The motivation for this combination is to provide the secondary package with some form of indicia relating to the manufacturer, product or use.

As to claim 15, it would appear the indicia or printed matter of EP 0 734 957 A1 must have been printed in some manner, which is sufficient to satisfy the claim limitations.

As to claim 16, Official Notice is taken for the use of labels as a well known means of applying printed matter to cartons. To use such a medium would have been obvious to one of ordinary skill in the art. The motivation for this combination is that labels can easily be modified to print various subject matter applied directly to the carton, rather than modifying the entire carton to reflect specific printed matter.

As to claim 37, the printed matter of EP 0 734 957 A1 includes identifying means to the extent that the manufacturer is identified. To impart this identical information to the label of claim 16 is directly suggested by the prior art. It is noted claim 37 depends from claim 14 that includes no said label. It is believed the dependency should be to claim 16.

Claim 38 relates to the printed matter and is treated in the same vein as paragraph 2 above.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3-18 and 36-43 have been considered but are moot in view of the new ground(s) of rejection. Claim 1 has been amended to now recite a packaging for at least one contact lens where information is provided relative to the contact lens rather than a prescription product. While this overcomes the prior anticipatory reference of Lupi

(Patent no. 5,755,462) pertaining to distribution of small quantities of medication in pill, tablet or capsule form, Lupi did pertain to contact lens, see pages 8 and 9 of applicant's remarks.

Claim 1 has also been amended to now recite customized graphics and identification means "being selected by the individual doctor prescribing said contact lens, wherein said customized graphics are specified at the time an order for said contact lens is placed with said manufacturer and said packaging is shipped from the manufacturer of said contact lens having said customized graphics and identification means on said packaging". However, it is submitted this language provides nothing novel over the prior art. Martin et al discloses a contact lens package with printed matter pertaining to "customized graphics and identifying means" as claimed. How, when and where such printed matter is applied in Martin et al pertains to the process by which the final product is made. Such limitations serve no useful patentable purpose in distinguishing product claims. Since applicant appears intent on defining the final product in terms of how the printed manner is imparted to the product, it appears these parameters would be better served in pursuing the method or system claims of this application.

Where the printed matter is specifically recited to include "customized graphics that identifies the person who is to receive the contact lens", "graphics that do not identify the prescription", "customized graphics that identifies the doctor prescribing the contact lens", "non-customized graphics identifying the manufacturer of the contact lens", "customized graphics comprising alphanumeric characters", "customized graphics comprising pictures" or "customized graphics that is a picture of the doctor" (see claims 3, 4, 5, 9, 17, 18, 40, 41, 42 and 43); this essentially relates to "printed matter". Contrary to applicant's position, it is not incumbent upon the prior art to show the specific type of graphics used in the type of package claimed when the specific graphics provided does not depend upon the package and the package does not depend upon the specific graphics, i.e., no functional relationship structurally. All the specific graphics, or printed matter, does is provide a different use of an existing product.

Accordingly, the printed matter is of no patentable distinction in the claimed invention.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Patent Electronic Business Center (EBC) will be the organizational contact for Patent Business external customers regarding questions about IFW images viewed in Private PAIR. External customers should be directed to EBC representatives, who can be reached at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. Additional information is available on the Patent EBC Web site at: <http://www.uspto.gov/ebc/index.html>.

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If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to David T. Fidei whose telephone number is (703) 308-1220. The examiner can normally be reached on Monday, Thursday and Friday 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Effective Monday morning, August 4, 2003, all official faxes for the TCs will be received in one central location in the Office. In cooperation with the Customer Service Goal Team, a new central official fax number (703-872-9306) has been established for use by the TCs. An OG notice will be issued and the Website updated to alert PTO customers of the new fax number. Official standalone (non-RightFax) fax machines will be removed from the TC fax centers, their phone numbers auto-forwarded to a single RightFax account, and faxes printed in the centralized fax center.

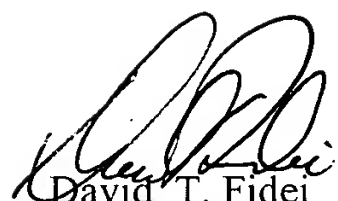
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David T. Fidei
Primary Examiner
Art Unit 3728

dtf

May 29, 2004

ⁱ A "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17(footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90; and *In re Marosi et al*, 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and the an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. During examination, the patentability of a product-by-process claim is determined by the novelty and non-obviousness of the claimed product itself without consideration of the process for making it which is recited in the claim. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

ⁱⁱ *In re Gulack*, 217 USPQ 410 (CAFC 1983)

ⁱⁱⁱ *In re John Ngai and David Lin* (CAFC, 5/13/2004), NONPRECEDENTIAL OPINION ISSUED March 8, 2004, PRECEDENTIAL OPINION ISSUED May 13, 2004.